REMARKS

Claims 1 through 5, 7, 8 and 10 are pending in this Application, of which claims 7, 8 and 10 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Claims 1, 3, 4 and 5 have been amended. Care has been exercised to avoid the introduction of new matter. Specifically, claims 3 through 5 have been placed in independent form. The remaining amendments address formalistic issues and find adequate descriptive support throughout the originally filed disclosure as, for example, the paragraph bridging pages 4 and 5 of the written description of the specification as submitted on January 15, 2004, as well as page 12 thereof, lines 16 through page 13, line 3. Applicants submit that the present Amendment does not generate any new matter issue.

Telephonic discussions on June 28, 2004.

Applicants express appreciation for Examiner Hoffman's courtesy in conducting telephonic interviews and exchanging telephone messages on June 28, 2004. Examiner Hoffman's comments were extremely helpful and, hopefully, will advance prosecution.

Specifically, during the telephonic discussions on June 28, 2004, Applicants pointed out that the substitute specification previously filed on January 15, 2004 adequately responded to the Examiner's request for a substitute specification. Significantly, Examiner Hoffman agreed and advised that the requirement for a substitute specification imposed in the February 9, 2004 Office Action has already been satisfied and there was no need to again respond to the requirement for a substitute specification.

In addition, Applicants asserted that the limitation in claim 1 with respect to changing a gas flow rate or composition supplied to a periphery of the lower end portion of the optical fiber preform was neither disclosed nor suggested by Roba, including at column

7, lines 37 through 40. Examiner Hoffman agreed but subsequently left a telephonic message advising that claim 1 did not specify whether it was the gas flow rate or the gas composition that is supplied to a periphery of the lower end portion of the optical fiber preform. This issue is addressed by the present Amendment.

Applicants submit that the present Amendment addresses each issue raised by the Examiner and places this Application in condition for allowance. Again, Examiner Hoffman's courtesy and suggestions are appreciated. For completeness, each of the issues raised in the February 9, 2004 Office Action is addressed *infra*.

Specification

The Examiner again required a substitute specification. As discussed *supra*, during the telephonic discussions on June 28, 2004, Examiner Hoffman agreed that this requirement was satisfied by the substitute specification submitted in the responsive Amendment on January 15, 2004. Accordingly, withdrawal of the requirement for a substitute specification is solicited.

Claims 3 through 5 were rejected under the first paragraph of 35 U.S.C. § 112.

In the statement of rejection the Examiner asserted there is no basis to change an amount of heat in response to the changing of a gas flow rate. This rejection is traversed.

Initially, Applicants would refer to page 12 of the specification submitted January 15, 2004, lines 16 through page 13, line 3, wherein adequate descriptive support for that limitation is found.

At any rate, claims 3 through 5 have been amended by deleting the limitation in issue, thereby overcoming the stated basis for the rejection.

The Examiner also raised an issue with respect to claim 1 as to a predetermined "changing." In response, claim 1 has been amended by replacing the word "changing" with "value" for clarity.

Based upon the foregoing Applicants submit that one having ordinary skill in the art would recognize from the originally filed disclosure that Applicants invented the claimed subject matter. *Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 54 USPQ2d (Fed. Cir. 2000) 1227.* Applicants, therefore, submit that the imposed rejection of claims 3 through 5 under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 and 3 through 5 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of rejection the Examiner again referred to the "changing" recited in line 10 of claim 1. This rejection is traversed.

In response the word "changing" has been replaced with the word "value".

The Examiner also raised an antecedent basis issue with respect to claim 4. Initially, Applicants would submit that the mere lack of a literal antecedent basis issue does not necessarily trigger a rejection under the second paragraph of 35 U.S.C. § 112 which is a legal issue. *Bose Corporation v. JBL, Inc., 274 F.3d 1354, 61 USPQ2d 1216 (Fed. Cir. 2001) (Antecedent basis).* At any rate, claim 4 has been amended to address the antecedent

basis issues raised by the Examiner thereby overcoming the stated basis for the imposed rejection of claim 4.

Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc., 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).* Applicants, therefore, submit that the imposed rejection of claims 1 and 3 through 5 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

Claim 1 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Roba.

In the statement of rejection the Examiner asserted that Roba discloses various features of the claimed invention, including a heat changing step, referring to column 7, lines 4 through 7 and 37 through 40. The Examiner then concluded that the claimed invention would have been obvious by broaching various differences between the claimed invention and the applied prior art without citing any additional factual basis. This rejection is traversed.

As discussed above, during the telephonic discussions of June 28, 2004, Applicants stressed, as they do now, that Roba neither discloses nor suggests a method comprising the manipulative step of changing the gas flow rate or gas composition (of a gas) supplied to a periphery of the lower end portion of the optical fiber preform. Clearly, one having ordinary skill in the art would have recognized from the originally filed disclosure as, for example,

the paragraph bridging pages 4 and 5 of the written description of the specification submitted January 15, 2004, that a gas is supplied to the periphery of the lower end portion of the optical fiber preform, and that at least one of the flow rate and composition **of that gas** supplied to the periphery of the lower end portion of the optical fiber preform is changed in response to the measured glass draw attention. Applicants would again refer to the paragraph bridging pages 4 and 5 to the written description of the specification submitted January 15, 2004, notably page 4 thereof, lines 21 through 23. For clarification claim 1 has been amended to clarify that at least one **of a gas flow rate and gas composition of a gas supplied to the periphery of the lower end portion of the optical fiber preform is changed**, paralleling the language appearing at page 4 of the written description of the specification submitted June 15, 2004, lines 21 through 23.

As apparently appreciated by the Examiner and agreed to during the telephonic discussions of June 28, 2004, Roba does not disclose the concept of changing the flow rate supplied to a periphery at the lower end portion of the optical fiber perform or changing the gas composition of gas supplied to a periphery at the lower end portion of the optical fiber preform. Moreover, Applicants would submit there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to modify Roba's method to arrive at the claimed invention. *In re Lee, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).*

Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Roba is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the for the foregoing it should be apparent that the request for a substitute specification has previously been satisfied and that the imposed rejections have been overcome, thereby placing all active claims in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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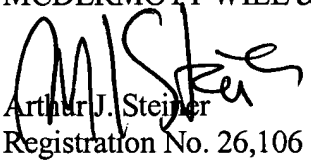

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